

## **REMARKS/ARGUMENTS**

As of the instant Office Action, Claims 28-35 and 38-47 were pending in the instant application. With this response, Applicants have canceled Claims 28-32 and 41-47, and amended the dependency of Claim 39. Applicants request the continued prosecution of Claims 33-35 and 38-40 on their merits. The amendments and cancellations were made without prejudice or disclaimer. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional and/or continuation-in-part applications.

### **I. Claim Rejections Under 35 U.S.C. §101 and §112, First Paragraph**

Claims 41-47 remain rejected under U.S.C. §101 allegedly “because the claimed invention in not supported by either a credible, specific and substantial asserted utility or a well established utility.” (Page 2 of the instant Office Action).

Claims 41-47 remain further rejected under 35 U.S.C. §112, first paragraph, allegedly “since the claimed invention in not supported by either a credible, specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.” (Page 2 of the instant Final Office Action).

Cancellation of Claims 41-47 renders this rejection moot. Therefore, withdrawal of the rejection under 35 U.S.C. §101 and §112, first paragraph, is respectfully requested.

### **II. Claim Rejections Under 35 U.S.C. §112, First Paragraph (Scope of Enablement)**

Claims 28-32 and 39-47 remain rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement for the recited polypeptide variants of PRO1303.

Applicants maintain for the reasons previously set forth in earlier responses that a description of the claimed genus has been achieved. However, in order to expedite prosecution, Applicants have canceled Claims 28-32 and 41-47 and amended Claim 39 to depend from Claim 33 without prejudice to filing a continuation application directed to the canceled subject matter.

Cancellation of Claims 28-32 and 41-47, and amendment of the claim dependency of Claim 39 renders this rejection moot. Therefore, withdrawal of the enablement rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

**III. Claim Rejections Under 35 U.S.C. §112, First Paragraph (Written Description)**

Claims 28-32 and 39-47 remain rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking adequate written description for the recited variant polypeptides of PRO1303.

Applicants maintain for the reasons previously set forth in earlier responses that a description of the claimed genus has been achieved. However, in order to expedite prosecution, Applicants have canceled Claims 28-32 and 41-47 and amended Claim 39 to depend from Claim 33 without prejudice to filing a continuation application directed to the canceled subject matter.

Cancellation of Claims 28-32 and 41-47 and amendment of the claim dependency of Claim 39 renders this rejection moot. Therefore, withdrawal of the written description rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

**IV. Claim Rejections Under 35 U.S.C. §102, Novelty**

Claims 28-35, 38 and 41-45 remain rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Youseff et al (Anticancer Research, 19:2843-2852 (1999)).

As made of record in the Preliminary Amendment filed August 29, 2002, Applicants claim priority for the instant application back to US provisional application 60/100,584, filed on September 16, 1998, and submit that 60/100,584 establishes that Applicants had conceived and reduced to practice the invention corresponding to the disclosure of the cited reference before the effective priority date of Youseff *et al.*

In order to overcome the 35 U.S.C. §102(a) rejection over Youseff *et al.* and support the priority claim, the US provisional application 60/100,584 simply needs to provide a disclosure commensurate in scope with the disclosure in Youseff *et al.* *In re Stempel*, 113 USPQ 77 (CCPA 1957)

Youseff *et al.* disclosed the amino acid sequence of a polypeptide (Youseff polypeptide) sharing 100% homology to PRO1303; and 2) homology between the predicted amino acid sequence and protein sequences deposited in GenBank.

Applicants submit that the U.S. Provisional Patent Application Serial No. 60/100,584 filed on September 16, 1998, provides the nucleic acid and amino acid sequences of the PRO1303 polypeptide (See U.S. Provisional Patent Application Serial No. 60/100,584 on page 13, under the section titled "Full-length PRO1303 polypeptides"). U.S. Provisional Patent Application Serial No. 60/100,584 discloses sequences designated as SEQ ID NO:1, which is identical to SEQ ID NO:193 of the present application, and SEQ ID NO:2, which is identical to SEQ ID NO:194 of the present application. In addition U.S. Provisional Patent Application Serial No. 60/100,584 discloses that PRO1303 has about 50% amino acid sequence identity with neuropsin and that is believed to be a newly identified member of the serine protease family. (See page 13, lines 15-20 of U.S. Provisional Patent Application Serial No. 60/100,584).

Applicants respectfully submit that the disclosures are commensurate in scope and that U.S. Provisional Patent Application Serial No. 60/100,584 discloses all that Youseff *et al.* disclose. Therefore, U.S. Provisional Patent Application Serial No. 60/100,584 clearly establishes that the invention commensurate in scope with Youseff *et al.* was conceived and reduced to practice prior to the 1999 publication.

Consequently, based on the holdings of *In re Stempel* and *In re Moore*, Applicants respectfully submit that Youseff *et al.* do not anticipate the polypeptide of SEQ ID NO:194 under 102(a) since their priority date is after the date this polypeptide was cloned and sequenced in the United States. Therefore, Youseff *et al.* do not anticipate the polypeptide of SEQ ID NO:194.

### **CONCLUSION**

In conclusion, the present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned agent at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. **07-1700** (referencing Attorney's Docket No. **123851-181898 (GNE-2830 P1C14)**).

Respectfully submitted,

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